

## **REMARKS**

Claims 1, 3-4, 10-11, 15-17, 19, and 23 are pending. Applicants have amended Claims 1 and 23. Support for the amendments of Claims 1 and 23 are found in paragraphs [0020], [0022], and [0025] of Applicants specification. Applicants have also added new claims 27-30. Support for these new claims are found in paragraphs [0019] and [0020] of Applicants specification. Therefore the current Claims under consideration are Claims 1 (as amended), 3-4, 10-11, 15-17, 19, 23 (as amended), and 27-30.

The Examiner rejected claims 1, 3-4, 10-11, 15-17, 19, and 23 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention. The Examiner states that it is not clear as to what “a mixture of glycerol triesters” refers to.

Applicants have deleted the phrase “a mixture of glycerol triesters” and replaced that phrase with “a mixture of polyol esters containing carboxylate groups of different chain length” (found in lines 1-2 of paragraph [0020] of Applicants specification). Thus Applicants believe the rejection of the Examiner has been rendered moot.

For the above reasons, the applicants believe that they have particularly pointed out and distinctly claimed the subject matter that they regard as their invention. Therefore, the applicants request that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1, 3-4, 10-11, 15-17, 19, and 23 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states that the Examiner is unable to find the basis of fatty acids in general.

Applicants have amended Claims 1 and 23 to recite “fatty acids having 8 to 32 carbon atoms” (found in lines 1-2 of paragraph [0025] of Applicants specification). Applicants believe this amendment renders the rejection of the Examiner moot.

For the above reasons, the applicants believe that they have particularly pointed out and distinctly claimed the subject matter that they regard as their invention. Therefore, the applicants

request that the rejection under 35 U.S.C. §112, first paragraph, be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1, 3, 10-11, 15-17, 19, and 23 under 35 USC 102(a) as being anticipated by Dickinson (GB 1 523 957). The Examiner states that the instant rejection will be removed when the rejections under 35 U.S.C. §112 are properly overcome.

Applicants believe that the rejections under 35 U.S.C. §112 have been overcome. Therefore Applicants respectfully request that this rejection be removed by the Examiner and the Claims allowed to issue.

The Examiner has rejected Claims 1, 3-4, 10-11, 15-17, 19, and 23, under 35 U.S.C. 103(a) as being unpatentable over Schmid (U.S. Patent No. 6,610,752) in view of L'Hostis (EP1075863). The Examiner admits that Schmid teaches depositing the polydiorganosiloxane, polyol ester, etc. in aqueous liquid form onto the particular carrier (col. 2, lines 5-30), but that water is eventually removed (col. 22, lines 12-25) and that as such the prior art's granulated foam control composition is obviously the same as the claimed granulated foam control composition where the polydiorganosiloxane, polyol ester, etc. is used in non-aqueous form.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure MPEP §2143. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness MPEP §2145 (X) (D). It is improper to combine references where the references teach away from their combination (MPEP §2145 (X) (D)). If the examiner believes there is factual support for rejecting the claimed invention under 35 U.S.C. §103, the examiner **must** then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant MPEP §2142.

By the Examiner's own admission, Schmid does not disclose that a mixture of foam control agent (i) and additive composition (ii) are deposited onto the particulate carrier in "non-aqueous liquid form" as currently claimed in independent claims 1 and 23. In fact, Schmid teaches away from depositing a mixture of foam control agent (i) and additive composition (ii) by teaching that their foam control agent and polyol ester are deposited in aqueous liquid form (i.e. in the form of an emulsion) as admitted above by the Examiner.

To further exemplify the criticality of this feature in Applicants invention as recited in the claims currently under consideration, Applicants attach a 132 Affidavit whereby the inventors on the instant application ran a comparison test, comparing the performance in a powdered detergent formulation of a granulated foam control composition where the foam control agent was mixed with an additive composition and then deposited onto a particulate carrier (a composition as instantly claimed) versus a composition where a granulated foam control composition was emulsified, and then the foam control composition and additive composition were separately deposited onto a particulate carrier (i.e. a granulated foam control composition prepared according to the teachings of Schmid). It is clear from the results in the attached 132 Affidavit that the compositions of the instant invention produced far less foam than the composition prepared according to the teachings of Schmid. It is the opinion of Applicants that the Examiner has not established a Prima Facie case of obviousness, however, in the event that the Examiner maintains this position, it is clear from the attached Affidavit that Applicants have successfully rebutted any prima facie case of obviousness established by the Examiner.

Applicants believe that the rejection under 35 U.S.C. §103(a) has been overcome. Therefore Applicants respectfully request that this rejection be removed by the Examiner and the Claims allowed to issue.

The Applicants hereby petition for a three (3) month extension of time to reply to the instant office action. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,  
Dow Corning Corporation

/Timothy J. Troy/  
Timothy J. Troy  
Reg. No. 36,951